

REMARKS

Reconsideration and reexamination of this application in light of the above amendments and the following remarks is respectfully requested. Claims 1-20 are pending in this application. Of these claims, 1, 10 and 17 are independent claims.

This response is submitted after a Final Office Action. The Applicant submits that the response places the application in a condition for allowance or, alternatively, in a better condition for appeal.

Rejection Under 35 U.S.C. §102(b)

Claims 1-3, 9, 10 and 16 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,655,958 to Lupi.

The Applicant respectfully traverses the 35 U.S.C. §102(b) rejection of claims 1-3, 9, 10 and 16.

The law is clear that anticipation requires that a single prior art reference disclose each and every limitation of the claim sought to be rejected. 35 U.S.C. 102(b).

The law is also clear that a claim in dependent form shall be construed to incorporate all the limitations of the claim to which it refers. 35 U.S.C. § 112 ¶ 4.

Independent claims 1 and 10 recite, among other things, a rotary edging wheel for edge finishing of an optical lens including at least one swarf clearing groove extending at an angle across a part of the outer circumferential cutting surface and opening into the radially extending planar side for removal of swarf out through the planar side. Such structure is not disclosed by Lupi.

The Examiner has asserted that Lupi discloses a swarf groove formed by wings 5 and 6. However, the Applicant respectfully submits that the Examiner is inadvertently misinterpreting the structure and function of wings 5 and 6. The purpose of the wings 5

and 6 are to mechanically interlock with the coating 12 that is formed completely therearound. In other words, the wings 5 and 6 are completely enveloped by the coating 12 and therefore cannot physically function as a swarf groove, as presently claimed.

In view of the foregoing, the Applicant respectfully submits that claims 1 and 10 define over the art cited by the Examiner and respectfully requests withdrawal of the rejection. Likewise, claims 2-3, 9 and 16, which depend from claims 1 and 10, further define the invention and define over the art cited by the Examiner. Thus, Applicant respectfully requests withdrawal of the rejection.

Furthermore, the Applicant submits that U.S. Patent No. 5,655,958 to Lupi does not render claims 1-3, 9, 10 and 16 obvious.

The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir.1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested

modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

As previously noted, independent claims 1 and 10 recite, among other things, a rotary edging wheel for edge finishing of an optical lens including at least one swarf clearing groove extending at an angle across a part of the outer circumferential cutting surface and opening into the radially extending planar side for removal of swarf out through the planar side. Such structure is not suggested by Lupi.

Reiterating, the purpose of the wings 5 and 6 are to mechanically interlock with the coating 12 that is formed completely therearound. Thus, the wings 5 and 6 are completely enveloped by the coating 12 and therefore cannot physically function as a swarf groove, as presently claimed. If one of ordinary skill in the art was attempting to form a swarf groove in a grinding wheel or tool, they most certainly would not look to Lupi for any guidance.

Rejection Under 35 U.S.C. §103

Claims 4-8, 11-15, and 17-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lupi.

The Applicant respectfully traverses the 35 U.S.C. §103(a) rejection of claims 4-8, 11-15, and 17-20.

Dependent claims 4-8, 11-15 and 17-20 depend from claims 1, 10 and 17, respectively. As set forth above, Lupi does not teach, suggest or render obvious the swarf clearing grooves of the present invention. In fact, Lupi does not disclose any swarf clearing grooves in an outer cutting surface of a grinding wheel. Thus, these claims dependent thereon are not rendered obvious when viewed in combination with these independent claims.

In view of the foregoing, the Applicant respectfully submits that claims 1, 10 and 17 define over the art cited by the Examiner and respectfully requests withdrawal of the rejection. Likewise, claims 4-8, 11-15 and 18-20, which depend from claims 1, 10 and 17, further define the invention and define over the art cited by the Examiner. Thus, Applicant respectfully requests withdrawal of the rejection.

Conclusion

In view of the foregoing, the Applicant respectfully requests reconsideration and reexamination of the Application. The Applicant respectfully submits that each item raised by the Examiner in the Office Action of December 31, 2001 has been successfully traversed, overcome or rendered moot by this response. The Applicant respectfully submits that each of the claims in this Application is in condition for allowance and such allowance is earnestly solicited.

The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Please send all future correspondence relating to this application to Warn, Burgess & Hoffmann, P.C., P.O. Box 70098, Rochester Hills, MI 48307.

Respectfully submitted,

WARN, BURGESS & HOFFMANN, P.C.
Attorneys for Applicant(s)

Dated: April 1, 2002

By: 

Philip R. Warn
Reg. No. 32775
Preston H. Smirman
Reg. No. 35365

P.O. Box 70098
Rochester Hills, MI 48307
(248) 364-4300

PRW/PHS/jmz